

REMARKS

This communication is filed in response to the Office Action having an electronic notification date of March 18, 2010. By virtue of the present response, the specification is amended. Claims 1-3, 11-13, 21, and 22 are amended. Support for the present amendments is provided, for example, in the *Specification* at [0041] that provides:

The eligible volume 96 is utilized to identify payments that qualify for the bonus program. For example, a merchant may sell products or services in multiple electronic marketplaces; however, a referrer may only receive credit under a specific bonus program for payments made in markets that are identified by the eligible volume 96 field. For example, a referrer will receive credit for a payment made in Marketplace A provided that the eligible volume 96 field identifies Marketplace A. Other embodiments may capture payments made in more than one marketplace.

No claims are canceled or added. Consequently, claims 1-22 remain pending in this application.

Specification Objections

Paragraph [0087] of the Published Application was objected to as having an incorrect figure number. Applicants have amended paragraphs [0076] and [0087] on page 2 of this response. Applicants note that this amendment was requested in the response filed April 24, 2009 and in the response filed November 19, 2009 and respectfully request that the amendment be entered and that the present objection be withdrawn.

§ 103 Rejection of the Claims

Claims 1-22 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Publication No. 2001/0020231 by Perri III et al. (*Perri*) in view of U.S. Publication No. 2003/0101131 by Warren et al. (*Warren*), U.S. Patent No. 7,191,151 to Nosek (*Nosek*), and U.S. Publication No. 2002/0151359 by Rowe (*Rowe*). Since no *prima facie* case of obviousness has been established, Applicants respectfully traverse.

The recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art

and **one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions**, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (*See KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); *see also* MPEP § 2143, emphasis added.)

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Applicants' claimed elements, with no change in the respective functions of the cited references, nor is there any substantiating evidence that the combination of the references would have yielded nothing more than predictable results. "If **any of these three findings** cannot be made, then this rationale [of combining prior art elements according to known methods to yield predictable results] cannot be used to support a conclusion that the claim would have been obvious." MPEP § 2143, emphasis added. Although other rationales for rejection under 35 U.S.C. §103(a) may exist, the basis for an obviousness rejection is still grounded in a consideration of all claim elements. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *See also* MPEP § 2143.03. Additionally, to render the claimed subject matter obvious, the prior art references must teach or suggest every feature of the claims. *See* Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Vaeck*, 947 F.2d, 488 (Fed. Cir. 1991). Cited approvingly in *Ex parte WEN WEN and PATRICIA NG at 7; Appeal No. 2009-000776; decided September 25, 2009.*

Applicants' claim 1 recites, *inter alia*:

[T]he plurality of payout conditions further including a condition that the received payment be made at a first marketplace of a plurality of marketplaces where the payment service may be used to receive payments.

None of the cited references, either singly or in combination, teach or suggest this element of claim 1. Regarding *Nosek*, the Examiner stated that "Payment service systems are known before invention time, e.g. Nosek . . . discloses such service." *Office Action*, page 6. *Nosek* is not further used by the Examiner to render the "bonus program" of claim 1 obvious. *See Office Action*, page 6 and page 10.

The system of *Perri* discusses:

[A]n interface between consumers and merchants to facilitate transactions. The system provides an incentive for people to contact the merchant in the future and to recommend the merchant to others. Thus, a purpose of the present system is *to increase traffic at the media of one or more merchants*. The particular media described herein is *a web site* on the World Wide Web portion of the Internet. *Perri* at paragraph [0052]; emphasis added.

The goal of *Perry*, therefore, is to “increase traffic” at “a web site” of the “one or more merchants.” *Perry* does not further discuss that a member (e.g., the merchant of claim 1) may interact with (e.g., receive payment from) the same merchant (e.g., payment system of claim 1) via more than one media or web site (e.g., a marketplace of claim 1). Because *Perri* assumes that each merchant has only one website, *Perri*, alone, does not teach or suggest that “a condition that the received payment be based on a payment made at a first marketplace of a plurality of marketplaces where the payment service may be used to receive payments.”

On page 8 of the *Office Action*, the Examiner relied exclusively on *Rowe* to teach or suggest a plurality of payout conditions including an initial hurdle and an initial payout. However, in contrast to Applicants’ claims, the casino player activity scheme of *Rowe* is used to reward a player based on his/her own behavior. *Rowe* further states:

In accordance with this embodiment, however, a player is permitted to *obtain account information regarding accounts associated with more than one entity via a single location*. . . For example, a player seeing that he is only a few points away from an award at one casino may play at that casino the next time he wishes to play instead of another casino where a substantial number of points are necessary to be entitled to a prize. *Rowe* at paragraph [0058]; emphasis added.

The player (e.g., a first party) of *Rowe* may access account information associated with accounts at various entities to calculate his own progress towards a next reward at a specific entity. The player’s award, however, does not depend on where (e.g., another casino) another player decides to play. As such, the reward does not depend on “a condition that the received payment [associated with account for the second party] be based on a payment made at a first marketplace of a plurality of marketplaces where the payment service may be used to receive payments” as recited by Applicants’ amended claim 1.

On page 9 of the *Office Action*, the Examiner relied exclusively on *Warren* to teach or suggest Applicants' claimed elements of the account being associated with one of a plurality of bonus programs. However, the account customization system of *Warren* is used to allow a user to select desired terms (e.g., terms for accumulating rewards) for an account. *Warren* at *Abstract*. *Warren* more specifically states:

In addition to being associated with the affiliated second entity, the account holder also receives the monetary benefit of the rewards program provided by the first entity. . . . Thus, while supporting the affiliated second entity, which may be a university, an environmental group, or a charity, the account holder also receives compensation from the first entity through the rewards program. *Warren* at paragraph [0086].

Here, the affiliated entity may gain rewards based on the activity of the cardholder from the rewards program of the first entity. More specifically, *Warren* states that, "the account provider provides compensation to the university or charity *based on usage of the account by the user.*" *Warren* at paragraph [0083] (emphasis added). The compensation of *Warren* to the university or charity (e.g., the first party of claim 1), however, is not conditioned upon "the received payment be[ing] based on a payment made at a first marketplace of a plurality of marketplaces where the payment service may be used to receive payments" as recited by Applicants' amended claim 1.

Further, assuming that the rewards systems of *Perri*, *Rowe*, and *Warren* can be combined, the resulting system does not render the method of claim 1 obvious. The combination of *Perri* and *Rowe* would include a third party referral system where a member of *Perri* is able to refer members to more than one merchant and where credits received from each merchant are tracked separately from credits received from other merchants. This combination, which merely results in tracking multiple accounts in a bonus system, does not teach or suggest the "payout conditions" of Applicants' claim 1. The addition of *Warren* might operate to compensate the referring member of *Perri* based on the activity of the referred member of *Perri*. The addition of the financial system of *Nosek* does not cure the deficiencies of the combination of *Perri*, *Rowe*, and *Warren*.

AMENDMENT AND RESPONSE UNDER 37 C.F.R § 1.116

Serial Number:10/772,530

Filing Date: February 4, 2004

Title: METHOD AND SYSTEM FOR INCENTIVIZING THE PROMOTION OF A PAYMENT SERVICE

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Since Applicants have shown that not all the claimed elements were known as required by *KSR*, other case law, or the MPEP, either by *Perri* singly or in any combination with *Warren*, *Rowe*, or *Nosek*, Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103 with regard to independent claims 1, 11, 21, and 22. Moreover, since claims 2-10 and 12-20 depend either directly or indirectly from claim 1 or 11, they too are allowable for at least the same reasons as the claims from which they depend. Further, these dependent claims may each be patentable for its own limitations.

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CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4051 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(408) 278-4051

Date 19 May 2010

By /Karen Kaufman/

Karen Kaufman
Reg. No. 57,239

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19th day of May 2010.

Chris Bartl
Name

/C.B/
Signature